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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,523	06/08/2001	Robert Plotkin	PAT0002	1429

7590

07/15/2004

Robert Plotkin  
18 Westminster Street  
Somerville, MA 02144

EXAMINER
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SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**RECEIVED**

**JUL 29 2004**

**Technology Center 2100**

**Office Action Summary**

Application No.

09/877,523

Applicant(s)

PLOTKIN, ROBERT

Examiner

Gautam Sain

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/06/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1-1) Claims 1,2,3,5,6,9,10,11,12, 13, 14, 15, 17, 18, 19, 25, 27, 28, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter (US 6473892, filed Dec 31, 1998).**

**Regarding claim 1, 25,** Porter teaches "receiving input from a user ... modification ... fixed information ... integration ... variable information," "a modified fixed information unit ... select fixed information unit" (ie., user inputs data on the form template that modifies the fields in the form and the merge system merges the changes to the form in the merge file ... the document generation system merges necessary paragraphs into a policy document as it creates the document where the user supplies the system with data that the system needs to determine which paragraphs are to be included in the document based on rules)(Background section, specifically, col 1, lines 15-20, col 2, lines 10-50).

**Regarding claim 2**, Porter teaches "modifying the select fixed information ... by the input" (ie., user inputs data and the system determines which paragraphs to include in the policy document, the document generation system merges the necessary paragraphs into a policy document)(col 2, lines 31-48).

**Regarding claim 3**, Porter teaches "replacing the select ... fixed information unit" (ie., interpreter replaces each instance of a word/phrase in the generated text with another word/phrase)(col 11, lines 40-45).

**Regarding claim 5, 27**, Porter teaches "identifying ... information unit" (ie., the system determines from the input data which paragraphs are to be included in the document)(col 2, lines 40-45).

Porter teaches "modifying ... fixed information unit" (ie., programmers update changes to laws, regulation and policies ... changes to the text of the documents the system produces)(col 5, lines 27-31).

**Regarding claim 6**, Porter teaches "adding to the ... fixed information unit" (ie., text generation code of the text generator that defines the paragraph that modifies the document ...)(col 15, lines 45-64).

**Regarding claim 9**, Porter teaches "receiving input ... information unit" (ie., based on user input data, the system determines which paragraphs are to be included in the document)(col 2, lines 37-41).

**Regarding claim 10**, Porter teaches "receiving input ... information unit" (ie., interactive document assembly system ... delete a clause)(col 2, lines 50-55).

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**Regarding claim 11, 28,** Porter teaches "receiving input from a user ... modification ... variable information ... integration ... variable information," "a fixed information unit ... information unit" (ie., user inputs data on the form template that modifies the fields in the form and the merge system merges the changes to the form in the merge file ... the document generation system merges necessary paragraphs into a policy document as it creates the document where the user supplies the system with data that the system needs to determine which paragraphs are to be included in the document based on rules)(Background section, specifically, col 1, lines 15-20, col 2, lines 10-50).

**Regarding claim 12,** Porter teaches "modifying the select variable information ... by the input" (ie., user inputs data and the system determines which paragraphs to include in the policy document, the document generation system merges the necessary paragraphs into a policy document)(col 2, lines 31-48).

**Regarding claim 13,** Porter teaches "replacing the select ... variable information unit ... by the input" (ie., variable field to be determined each time a document is created from the form where the use can enter information through the form and replaces each instruction or variable name in brackets with data that is appropriate for the document being created)(col 1, lines 15-50).

**Regarding claim 14, 29,** Porter teaches "generating a second document ... by the input" (ie., merge system merges data into a merge file with changes to the form)(col 2, lines 17-30).

**Regarding claim 15**, Porter teaches "adding to ... modification indicated by the input" (ie., text generation code of the text generator that defines the paragraph that modifies the document ...; based on use input data, the document generation system determines which paragraphs are to be included in the document from the store of all paragraphs)(col 15, lines 45-64).

**Regarding claim 17**, Porter teaches "receiving input ... variable information unit" (ie., text in a form with variable fields ... replaces each instruction or variable name in brackets with data ...)(col 1, lines 15-67).

**Regarding claim 18**, Porter teaches "receiving input ... addition ... variable information unit" (ie., insert a variable field in a document assembly system with forms)(col 2, lines 49-60).

**Regarding claim 19**, Porter teaches "receiving input ... deletion ... information unit" (ie., delete a variable field)(col 2, lines 49-60).

**Regarding claim 21**, Porter teaches "integrating ... integration specification" (ie., merge system that merges variable fields that user enters with the form)(col 2, lines 1-30; col 1, lines 15-25).

**Regarding claim 22**, Porter teaches "replacing the ... fixed information unit" (ie., interpreter replaces each instance of a word/phrase in the generated text with another word/phrase)(col 11, lines 40-45).

**Regarding claim 23**, Porter teaches "adding ... information unit" (ie., based on user input data, the system determines which paragraphs are to be included in the document)(col 2, lines 37-41).

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**Regarding claim 24**, Porter teaches "applying properties ... fixed information unit" (ie., the form with fixed fields is applied to the documents each time a new document is created, which will inherit the fixed properties of the template/form).

***Claim Rejections - 35 USC § 103***

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2-1) Claims 4, 8, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (as cited above), in view of Shirley et al (US 5692206, issued Nov 1997).**

**Regarding claim 4, 26**, Porter does not expressly teach, but Shirley teaches "generating a second document ... information unit" (ie., contract authoring system takes standard contract documents and creates a new version of the contract document having new provisions)(col 2, lines 37-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Porter to include a document authoring system that creates a new version of a document with new provisions as taught by Shirley, providing the benefit of customized generation of documents in a format selected by the user (Shirley, col 2, lines 8-15, lines 55-58).

**Regarding claim 8**, Porter does not expressly teach, but Shirley teaches "receiving input ... information unit" (ie., contract generation system includes alternate



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provision that can replace provision in the standard documents as well as supplemental and additional provisions that can be added to the standard documents; input data)(Abstract section , middle; col 2, lines 8-16; col 1, lines 35-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Porter to include a document generation system that replaces standard documents with supplement provisions with user input as taught by Shirley, providing the benefit of a flexible system that gives a user of the contract generation program more flexibility in defining the terms of a particular contract ... in a greater variety of situations (col 1, line 65 – col 2, line 5).

**2-2) Claims 7, 16, 20, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (as cited above), in view of Pirolli et al (US 6151595, filed Apr 17, 1998).**

**Regarding claim 7,** Porter does not teaches, but Pirolli teaches “fixed information unit specifiers ... priorities and where in ... fixed information unit” (ie., prioritizing (ranking) of graph structure based on usage information and degree of interest for graph visualization ... in information retrieval, hypertext document ...)(col 7, lines 28 – 58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Porter to include prioritizing or ranking of graph structures based on usage information as taught by Pirolli, providing the benefit of minimizing cognitive load

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(Pirolli, col 7, lines 33-34) and improving the relationship between web page contents and to efficiently structure web sites' (col 1, lines 55-59).

**Regarding claim 16**, Porter does not teaches, but Pirolli teaches "fixed information unit specifiers ... priorities and where in ... default information unit priority" (ie., prioritizing (ranking) of graph structure based on usage information and degree of interest for graph visualization ... in information retrieval, hypertext document ...)(col 7, lines 28 – 58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Porter to include prioritizing or ranking of graph structures based on usage information as taught by Pirolli, providing the benefit of minimizing cognitive load (Pirolli, col 7, lines 33-34) and improving the relationship between web page contents and to efficiently structure web sites' (col 1, lines 55-59).

**Regarding claim 20, 30**, Porter does not teaches, but Pirolli teaches "fixed information unit specifiers ...fixed information unit having a priority" (ie., prioritizing (ranking) of graph structure based on usage information and degree of interest for graph visualization ... in information retrieval, hypertext document ...)(col 7, lines 28 – 58).

Porter teaches "document data ... information" (ie., document ... variable field ... form)(col 1, lines 15-20).

Porter teaches "in information ... variable information" (ie., merge system for merging changes to the form)(col 2, lines 17-30).

Porter teaches "initializing ... initial value" (ie., preprinted form includes the fixed text in preprinted form)(col 1, lines 18-20).

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Porter does not teach, but Pirolli teaches "... order of priority" (ie., prioritizing of structure based on usage information and degree of interest of graph visualization ... in information retrieval, hypertext document)(col 7, lines 28-58).

Porter teaches "generating an interim fixed information unit ... u" (ie., a form template with fixed field that is used to create a document)(col 1, lines 15-20).

Porter teaches "applying ... unit" (ie., each time a document is created, it is using fixed fields of the form/template)(col 1, lines 15-20)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Porter to include prioritizing or ranking of graph structures based on usage information as taught by Pirolli, providing the benefit of minimizing cognitive load (Pirolli, col 7, lines 33-34) and improving the relationship between web page contents and to efficiently structure web sites' (col 1, lines 55-59).

#### ***Other Cases***

- 3) A. Clapp (US 5893914, issued Apr 1999).
- B. Clapp (US 5313394, issued May 1994).
- C. Petruzzi et al (US 6049811, issued Apr 2000)

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777. The examiner can normally be reached on M-F 9-5 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS  
GS

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER

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## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 1

of 2

**Complete if Known**

Application Number	09/877,523
Filing Date	06/08/2001
First Named Inventor	R. Plotkin
Group Art Unit	2176
Examiner Name	N/A
Attorney Docket Number	PAT0002

**U.S. PATENT DOCUMENTS**

[illegible]

**FOREIGN PATENT DOCUMENTS**

[illegible]

Examiner  
Signature

Date  
Cons

**Considered**

6-29-04

Examiner Signature	<i>G. A. H.</i>	Considered	<input checked="" type="checkbox"/>
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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Sheet 2 of 2

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<b>Notice of References Cited</b>	Application/Control No. 09/877,523	Applicant(s)/Patent Under Reexamination PLOTKIN, ROBERT	
	Examiner Gautam Sain	Art Unit 2176	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,473,892 B1	10-2002	Porter, Laureston Craig	717/106
	B	US-5,692,206	11-1997	Shirley et al.	715/531
	C	US-6,151,595 A	11-2000	Pirolli et al.	707/1
	D	US-5,893,914	04-1999	Clapp, Barbara	715/507
	E	US-5,313,394	05-1994	Clapp, Barbara	715/531
	F	US-6,049,811 A	04-2000	Petruzzi et al.	715/507
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**FOREIGN PATENT DOCUMENTS**

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